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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,956	11/14/2003	Chung-Kuang Lin	BHT-3118-44	7777

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EXAMINER

AYRES, TIMOTHY MICHAEL

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/706,956	LIN ET AL.	
	Examiner	Art Unit	
	Timothy M. Ayres	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7, 9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10, and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a second and final office action on the merits of application SN 10/706,956.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 8, and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5,7, and 8 of U.S. Patent No. 6,736,151 in view of itself. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose the same structure with a spring rib or resilient rib being used to transfer energy from a spring device or buffer device that is located in the stretcher rib out to a joint on the intermediate rib. Both disclose a slide member that has a hook that protrudes through a slot in the stretcher rib. Although not specified in the claims of patent 6,736,151 the joint would be the same and is implied by the drawings.

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3. Lin ('151) does not disclose expressly that the joint be p shape, that the resilient connecting rib has two retainers, and the two axis of the joint are unaligned. Lin ('151) does disclose an integral joint on the intermediate rib (23) that is p-shaped (Fig. 2). At the time of the invention it would have been obvious for a person of ordinary skill in the art to take the joint on the rib (27) and use the shape of the joint that is used on the intermediate rib. In regards of the two retainer clips, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Although Lin does not expressly disclose that the joints have axis unaligned it is well known that if four-arm linkages have their axis become aligned or become over aligned that the linkage will jam or stick. Accordingly, it would have been obvious for one of ordinary skill in the art to design the ribs with joints that won't align.

4. Claims 5 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5,7, and 8 of U.S. Patent No. 6,736,151 in view of U.S Patent 5,553,634 to Yang. Lin ('151) discloses every element as applied above. Lin ('151) does not disclose expressly the intermediate rib being formed of plastic, having two retainers, and having different sized grooves. Yang ('634) discloses an intermediate rib as integrally formed by plastic molding process (Col. 1, line 54-55). He discloses a top rib with an H shaped cross section. Lin ('151) and Yang ('634) are analogous art because they are both directed towards the rib structure of umbrellas. At the time of the invention it would have been obvious for a person of

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ordinary skill in the art to take the rib structure of Lin ('151) and make the intermediate rib of Yang out of plastic to allow different groove shapes and sizes such as the shape Yang uses on his top rib. In regards of the two retainer clips, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. In regards to the shallow groove, it would have been an obvious matter of design choice to modify the sizes of the grooves of Yang's H cross section, since such a modification would have involved a mere change in the size of a component and the applicant has not disclosed that having a shallow groove solves any stated problem or is for any particular purpose. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237(CCPA 1955).

5. Claims 2-4 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5,7, and 8 of U.S. Patent No. 6,736,151 in view of U.S Patent 5,553,634 to Yang. Lin ('151) discloses every element as applied above. Lin ('151) does not disclose expressly the stretcher rib having narrow and wide grooves, the slide member being a rod, and having the spring attached adjacent to the runner. Yang ('634) discloses a top rib with an H shaped cross section. Lin ('151) and Yang ('634) are analogous art because they are both directed towards the rib structure of umbrellas. At the time of the invention it would have been obvious for a person of ordinary skill in the art to take the rib structure of Lin ('151) and make the stretcher rib have two grooves such as the shape Yang uses on his top rib to

make the umbrella compress more. It would have been an obvious matter of design choice to modify the sizes of the grooves of Yang's H cross section, since such a modification would have involved a mere change in the size of a component and the applicant has not disclosed that having a shallow groove solves any stated problem or is for any particular purpose. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237(CCPA 1955). In regards to the rod as the slide member and the spring being attached adjacent to the runner, it would have been obvious matter of design choice to modify the slide member of Yang ('634) by having it made in the shape of a rod and to move the spring attachment location, since the applicant has not disclosed that having the slide member of rod shape or moving the spring end closer to the runner solves any stated problem or is for any particular purpose and it appears that the slide member and spring would perform equally well in shape and location disclosed by Yang.

Response to Arguments

6. Applicant's arguments filed October 10th, 2005 have been fully considered but they are not persuasive. The Lin '151 patent is a four-rib umbrella assembly and this application is a three-rib umbrella assembly which is well known and Lin '151 could easily be changed to a three rib umbrella assembly making the tail rib (26) of this application corresponds to intermediate rib (27) of Lin '151. The structure of the spring rib and buffer device is identical. The fact that they have different spring functions does not make them patently distinct, even though the spring function should be similar when

comparing the intermediate rib (27) of Lin '151 to the tail rib (26) of this application. Applicant's claims still are met by Lin '151 in that the structure is the same as to allow this application's umbrella to minimize the wind force.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Ayres whose telephone number is (571) 272-8299. The examiner can normally be reached on MON-THU 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TMA
12/06/05



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